

Amendments to the Drawings

No amendments are made to the Drawings herein.

Remarks

By the foregoing Amendment, Claims 1, 6 and 7 are amended. Entry of the Amendment, and favorable consideration thereof is earnestly requested.

The Examiner has maintained his objection to the drawings because of failure to show every feature of the invention specified in the claims. In particular, the Examiner has stated that the full ring or lining, the segments, the anchors and the wear parts must be shown or the features cancelled from the claims.

As pointed out by Applicant in the Response filed on January 13, 2005, however, the anchor parts and the wear parts are shown with reference numerals 4 and 10 respectively in Fig. 1 as originally filed. As such, Applicant respectfully asks that the Examiner reconsider his objection to the drawings as not showing the anchor parts and the wear parts.

With respect to the full ring or lining and the segments, Applicant has, in the Response filed on January 13, 2005, introduced Figs. 4 and 5. Fig. 4 illustrates the brake lining extending in a full circle ring on the brake disc, and Fig. 5 illustrates the brake lining divided into two or more (e.g., three) ring segments extending a full circle ring on the brake disc. The Examiner has, however, objected to entry of these Figures and the brief description thereof under 35 U.S.C. 132(a) as introducing "new matter" into the disclosure. Applicant respectfully asks the Examiner to reconsider this objection.

Applicant first notes that the subject matter in question (i.e., the full ring or lining and the segments) is clearly disclosed in the Specification and Claims as originally filed. Such subject matter can be found, for example, in Paragraph [0019] and Claims 2 and 3 of the Application as originally filed. As such, the subject matter of the full ring or lining and the segments cannot be new matter. Applicant respectfully submits that all that it has done is added Figures showing the subject matter already contained in the

specification, and has amended the Specification to reference those Figures. Applicant respectfully submits that it has not added any subject matter not already disclosed in the Application as originally files.

Moreover, Applicant respectfully submits that it is perfectly appropriate to add Figures to the Specification through amendment, which Figures show subject matter disclosed in the original Application. In support of this, Applicant respectfully directs the Examiner's attention to MPEP 706.03(o), which states as follows: "If subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim is not rejected but applicant is required to add it to the drawing. See MPEP § 608.01(I)." MPEP 608.01(I), in turn, states that:

Where subject matter not shown in the drawing or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter. The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description. It is the drawing and description that are defective, not the claim.

(emphasis added). Thus, the MPEP itself makes clear that when claimed subject matter is not shown in the drawings, such a deficiency can and should be obviated by adding the claimed subject matter to the specification (if not already present therein) and to the drawings. In the present case, the claimed subject matter in question (i.e., the full ring or lining and the segments) was already disclosed in the specification, but not in the drawings. Applicants properly corrected this deficiency by adding figures showing the subject matter in question. The Figures do not show any "new" subject matter, but only subject matter that was contained in the Application as originally filed.

Accordingly, Applicant respectfully asks that the Examiner reconsider his objection to the drawings as not showing the full ring or lining and the segments, as well as his "new matter" objection under 35 U.S.C. 132(a).

Claims 1-2 and 4 stand rejected under 35 U.S.C. 102(b) as being anticipated by Takakura, et al. (U.S. Patent No. 5,975,267), while Claims 3 and 5-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the same reference, Takakura, et al. (U.S. Patent No. 5,975,267). Applicant respectfully asks the Examiner to reconsider these rejections in view of the above Amendments and the below Remarks.

Applicant initially notes that Claim 1 has been amended to include all limitations of Claim 6, and Claim 6 has been cancelled.

The present invention is directed to a disc brake comprising a caliper, a brake disc and a brake pad received in a pad holder. The brake disc and pad holder are axially moveable in relation to the caliper. The brake disc is furnished with a brake lining material on one side. By placing the lining material all around one side of the brake disc the same braking capacity is retained, while the total width of the lining material and the brake pad is less than the total width of two brake pads, arranged on both sides of the disc. A brake pad is normally only acting on a part of the brake disc, while a brake disc having a brake lining material on one side may be active along a full circle ring. Thus, it is possible to have the same effect with a thinner lining material on the disc as compared to the thickness of a brake pad. Furthermore, the brake caliper may be formed in such a way that the heat produced in breaking is distributed in a suitable way. Thus, the caliper is formed to lead off as much heat as possible.

One of the specific design elements that allows for these objects to be achieved is the provision of one or more wearing parts placed in the caliper for contact with the brake lining of the brake disc during braking. Claim 1 has been amended to specifically require this element, and Claim 6 has been amended accordingly.

Applicant respectfully submits that Takakura, et al. does not disclose, teach or suggest a wearing part placed in the caliper as required by Claim 1 as amended. The Examiner has expressly recognized this, but has asserted that it would have been

obvious to one of ordinary skill in the art to have utilized these elements (see Paragraph 8 of the outstanding Final Office Action). Applicant respectfully disagrees.

It is well settled that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). It is also well settled that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, Applicant respectfully submits that not only is there no motivation to modify Takakura, et al. to include wearing parts, but that such modifications would make the device of Takakura, et al. work less efficiently.

As discussed above, the present invention is directed to a disc brake system. In such a system, the wearing parts are advantageous so as to provide localized wearing surfaces, rather than allowing the caliper to wear. In this application, as the wearing parts become worn down, they can be easily replaced. For example, the wearing parts can be replaced as part of the routine maintenance of replacing the brake pads. Such routine maintenance is contemplated as part of operating disc brakes, and there is minimal additional burden involved with replacing the wearing parts.

However, Takakura, et al. is not concerned with disc brakes, but instead is directed to a friction clutches of the kind incorporated into automatic transmission systems. Applicant respectfully submits that it would be highly undesirable to incorporate wearing parts of the type claimed into such an automatic transmission system. Unlike disc brakes, automatic transmission systems do not require routine maintenance (e.g., the changing of brake pads). Moreover, it is difficult and labor intensive to disassemble such systems. As such, one skilled in the art would want to avoid the provision of wearing parts in such systems. Applicant, therefore, submits that

not only is there no motivation provided to modify Takakura, et al. to include wearing parts of the type claimed, but also that one skilled in the art would be taught against such a modification,

Furthermore, Takakura et al. is particularly concerned with minimizing the thickness of the discs 52, 54 forming the friction clutch mechanism, and of the entire assembly itself. However, if wearing parts were to be installed in discs 52, 54, the thickness of discs 52,54 would have to be increased to accommodate such wearing parts. Such an increase in thickness would be contrary to the teachings of the reference itself, and Applicant respectfully submits that one would not make such modifications, particularly in view of the complete absence of any motivation provided by the reference to make such a modification.

For the foregoing reasons, Applicant respectfully submits that all pending claims, namely Claims 1-10, are patentable over the references of record, and earnestly solicits allowance of the same.

Respectfully submitted,



Wesley W. Whitmyer, Jr., Registration No. 33,558
Todd M. Oberdick, Registration No. 44,268
Hyun Jong Park, Limited Recognition
Attorneys for Applicants
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155